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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,331	10/04/2000	Pierre Deslongchamps	6670/0H748	6557

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Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

EPPERSON, JON D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,331

Applicant(s)

DESLONGCHAMPS ET AL.

Examiner

Jon D. Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-42 is/are pending in the application.
- 4a) Of the above claim(s) 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. 12 May 2005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination (RCE)

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (e.g., see 7/15/05 Response). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/16/05 has been entered. Claims 34-36 were pending. Applicants amended claims 34-36 and added new claims 37-42. Therefore, claims 34-42 are currently pending. An action on the merit follows.

Those sections of Title 35, US code, not included in the instant action can be found in previous office actions.

Status of the Claims

2. Newly submitted claims 37-42 are directed to inventions that are independent and/or distinct from the invention originally claimed for the following reasons: Claims 37-39 are directed to a library of compounds that are not limited to the currently claimed cyclic RGD macrocycles. Different reagents and materials are required to produce a library (e.g., combinatorial procedures) and a library is also used for a different purpose than a single compound (e.g., screening). In addition, the library can be separately classified (e.g., class 435, DIG 35) than RGD macrocycle (e.g., class 530, subclass 317) and does not necessarily contain Applicants' currently claimed RGD macrocycle (e.g., library contains many unrelated members). Thus, the search in both the patent and non-patent literature would not be coextensive. Claims

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40-41 are drawn to a method of using the library of compounds as disclosed in claims 37-39 and thus are not properly rejoined with the currently claimed RGD macrocycles. This screening method is also separately classified (e.g., class 435, DIG 15) and would also constitute a separate and burdensome search for all the reasons stated previously for the claimed library. Likewise, the assay kit also depends on the non-elected library of claims 37-39 and is also separately classified (e.g., class 435, subclass 975). Consequently, new claims 37-42 are drawn to different products, methods and/or kits (i.e., e.g., which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s), screening of different characteristics, such as different binding affinities, different biochemical reaction conditions, etc. or lead to different final results). Therefore, the groups that describe these products and methods have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for the prosecution on the merits. Accordingly, claims 37-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Therefore, claims 34-36 are examined on the merits.

Withdrawn Objections/Rejections

4. All previous rejections and/or objections are withdrawn in view of Applicants' arguments and/or amendments.

New Rejections

Claims Rejections - 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 34-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

A. Claims 34-36 were amended in the 5/16/05 response. However, applicant did not show where support for these amendments and/or additions can be found in the specification. Specifically, the current amendment for claim 34 removes the previous requirement that the A1-A2-A3 fragment be linked by "amide" bonds. That is, the N-terminus/C-terminus orientation for A1, A2 and A3 is no longer specified. Thus, A1 could be linked to A2 via a N-N bond instead of a peptide amide bond. Likewise, A2 could be linked to A3 via a -C(=O)-C(=O)- bond instead the previously disclosed peptide amide bond. There is no support for this amendment. For example, Applicants' specification only teaches the formation A1-A2-A3 joined by peptide linkages, not the

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“reverse” i.e., NH-NH or C(=O)-(C=O) linkages (e.g., see specification, figures 2-4). If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP 714.02. Therefore, claim 34 and all dependent claims are rejected under 35 U.S.C. 112, first paragraph, as containing new matter.

Conclusion

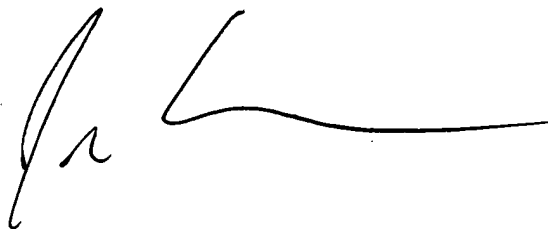
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.
October 11, 2005

A handwritten signature in black ink, appearing to be 'J. Epperson', written in a cursive style.